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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,957	07/14/2003	Mitsushi Yamamoto	UNIU79.013AUS	6418

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EXAMINER	
CHANG, VICTOR S	

ART UNIT	PAPER NUMBER
1783	

NOTIFICATION DATE	DELIVERY MODE
08/25/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/618,957	YAMAMOTO ET AL.	
	Examiner	Art Unit	
	VICTOR S. CHANG	1783	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 July 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8,10-17 and 19-23* is/are pending in the application.

4a) Of the above claim(s) *13,16 and 17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8,10-12,14,15 and 19-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Introduction

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' arguments and amendments filed 7/29/2010 have been entered. The specification and claims 8 and 14 have been amended. New claim 23 has been entered. Claims 8, 10-12, 14, 15 and 19-23 are active.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. In response, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More particularly, the term "antistatic agent" lacks antecedent basis. Clarification is required in the next reply.

Claim Rejections - 35 USC § 103

6. Claims 8, 10-12, 14, 15 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi (US 6582789) in view of Masuda (US 20020064650A1).

Sumi's invention relates to a protective film for liquid crystal display. See Abstract. The film is treated by an antistatic agent on the surface of the surface protective film opposite to the surface in which the adhesive layer is formed. See Abstract. Useful films include biaxially oriented polyethylene terephthalate (PET) film. See col. 3, ll. 6 and 18. The thickness of the adhesive layer is preferably 3 to 50 micrometers. See col. 5, ll. 60. Examples of adhesives include acrylic adhesive having 2-ethylhexyl acrylate as a main monomer, vinyl acetate as a comonomer and hydroxyethyl methacrylate as a functional group-containing monomer in a ratio of 7:2:1. See col. 15, ll. 60-63.

For claims 8, 10-12, 14, 15 and 19-22, Sumi lacks a teaching to form the antistatic layer of polymers having pyrrolidinium rings as multiple repeating units in main chains. However, Masuda's invention relates to a polyester film for window application. See Abstract. The film comprises at least one side thereof an antistatic coating. The antistatic coating has a specific surface resistance of not more than 1.0×10^{13} Ω, and a haze of not more than 5.0% and a visible light transmittance of 3 to 70% (transparent). See [0012]. Examples of the antistatic agents include polymers having a backbone containing repeating units of pyrrolidinium rings. See [0031]. Examples of useful polyesters include polyethylene terephthalate (PET), etc. See

[0017]. On the side opposite from the antistatic coating of the polyester film, an adhesive is applied for pasting the film on window glass. See [0044]. It would have been an obvious modification to one of ordinary skill in the art to modify the antistatic layer of Sumi with polymers having pyrrolidinium rings as multiple repeating units in main chains, as taught by Masuda, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Regarding the use limitations in the preamble, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Regarding the functional limitation "being configured to maintain transparency even after one-hour heat treatment at 150°C", absent any evidence to the contrary, it is deemed to be inherent to the same structure and composition of the film as the claimed invention, which is rendered obvious by the collective teachings of prior art as set forth above. Regarding newly added limitation "wherein said transparent surface protective film does not contain a light absorbing compound" in claim 8, nowhere has Sumi taught that the protective film necessarily requires a light absorbing compound. Regarding new added limitation "wherein the entirety of the surface protective film is transparent upon visual inspection" in claim 14, absent a standard for the term "visual inspection", any visually transparent meets the limitation. Since Sumi's protective film is used for liquid crystal display, it is necessarily transparent for a display viewer.

7. Claims 8, 10-12, 14, 15 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-256116 (machine translation) in view of Masuda (US 20020064650).

JP '116 relates to a transparent surface-protective film for various displays. See [0002]. The film comprises a highly transparent polyethylene terephthalate (PET) film, which is preferably biaxially oriented. An antistatic layer is provided on one side of the PET film, and an adhesive layer is provided on the opposite side. See [abstract]. The thickness of the adhesive layer is 3-100 micrometers. See [0040]. Useful adhesives include acrylic pressure sensitive adhesive. See [0035].

For claims 8, 10-12, 14, 15 and 20-22, JP '116 lacks a teaching to form the antistatic layer of polymers having pyrrolidinium rings as multiple repeating units in main chains. However, Masuda's invention relates to a polyester film for window application [abstract]. The film comprises at least one side thereof an antistatic coating. The antistatic coating has a specific surface resistance of not more than 1.0×10^{13} Ω, and a haze of not more than 5.0% and a visible light transmittance of 3 to 70% (transparent). See [0012]. Examples of the antistatic agents include polymers having a backbone containing repeating units of pyrrolidinium rings. See [0031]. Examples of useful polyesters include polyethylene terephthalate (PET), etc. See [0017]. On the side opposite from the antistatic coating of the polyester film, an adhesive is applied for pasting the film on window glass. See [0044]. It would have been an obvious modification to one of ordinary skill in the art to modify the antistatic layer of JP '116 with polymers having pyrrolidinium rings as multiple repeating units in main chains, as taught by Masuda, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Regarding the use limitations in the preamble, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399,

1403, 181 USPQ 641, 644 (CCPA 1974). Regarding the functional limitation "being configured to maintain transparency even after one-hour heat treatment at 150°C", absent any evidence to the contrary, it is deemed to be inherent to the same structure and composition of the film as the claimed invention, which is rendered obvious by the collective teachings of prior art as set forth above. Regarding the limitation "wherein the entirety of the surface protective film is transparent upon visual inspection" in claim 14, absent a standard for the term "visual inspection", any visually transparent meets the limitation. Since JP '116 relates to a highly transparent film, it is inherently transparent for a viewer.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-256116 (machine translation) in view of Masuda (US 20020064650) and Sumi (US 6582789).

The teachings of prior art are again relied upon as set forth above.

For claim 19, the prior art is silent about the amount of co-monomer in the acrylic adhesive. However, Sumi's invention relates to a protective film, and exemplifies a useful acrylic adhesive comprising 2-ethylhexyl acrylate as a main monomer, vinyl acetate as a comonomer and hydroxyethyl methacrylate as a functional group-containing monomer in a ratio of 7:2:1. See col. 15, ll. 60-63. It would have been an obvious to one of ordinary skill in the art to select a known acrylic adhesive composition of Sumi to make the protective film of JP '116, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

Response to Arguments

9. Applicants argue at Remarks page 6:

> "Masuda's teachings are directed to films that are excellent in shielding light. In contrast, Sumi's invention is directed to a surface protective film that "can be highly transparent and improve inspectability." Sumi at Abstract (emphasis added). Thus, Sumi teaches the importance of high transparency in Sumi's invention. One of skill in the art wishing to modify the teachings of Sumi's teachings of a highly transparent film would not look to teachings that are directed to a film with excellent light shielding effect. In particular, there is no reason that one of ordinary skill would selectively choose a component of an "excellent light shielding" film for purposes of incorporating into a "highly transparent" film."

However, nowhere has Masuda teaches that the light shielding property is light shielding effective. To the contrary, Masuda teaches that the light shielding property is the dye additive in the film substrate. Applicants' argument directed to Masuda regarding features not relied upon is misplaced and unpersuasive.

Applicants argue at page 6:

> "the transparent surface protective film of the presently claimed invention contains pyrrolidinium rings in the main chain of a component polymer. As a result of the present of these pyrrolidinium rings, deposition of oligomer, even after one-hour heat treatment at 150°C, is prevented. See Specification atpage 5, first full paragraph. This prevention of deposition of oligomer leads to the outstanding properties of the present invention, which facilitates visual inspection of the transparent conductive substrate, and prevents separation of the oligomers in the inspection process and manufacturing process. Id. These superior properties are not taught by either Sumi or Masuda, alone or combined."

However, absent any evidence to the contrary, it is deemed to be inherent to the same structure and composition of the film as the claimed invention, which is rendered obvious by the collective teachings of prior art as set forth above.

For the same reasons set forth above, applicants' arguments at Remarks pages 7-8 relating to Masuda's features not relied upon for the grounds of rejections are immaterial to and unpersuasive.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 6:00 am - 4:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1783